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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,301	08/31/2001	Maria A. Glucksmann	381552003600	2014

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EXAMINER
PATTERSON, CHARLES L JR

ART UNIT	PAPER NUMBER
1652	

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/945,301	GLUCKSMANN ET AL.	
	Examiner	Art Unit	
	Charles L. Patterson, Jr.	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-24* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-3 and 6-8, drawn to a nucleic acid molecule, a host cell containing the nucleic acid molecule, a method of making a polypeptide by culturing the host cell, a method of detecting the presence of the nucleic acid, a kit comprising a compound which hybridizes to the nucleic acid, classified in class 435, subclass 6, 189 and class 536, subclass 23.2.

II. Claims 4 and 7-10, drawn to a polypeptide, a method of detecting the polypeptide, a kit comprising a compound which binds to the polypeptide, a method for identifying a compound which binds to or modulates the activity of the polypeptide, a method of modulating the activity of the polypeptide, classified in class 435, subclass 25, 189.

III. Claim 5, drawn to an antibody, classified in class 530, subclass 387.9.

IV. Claims 11-12, 14-15 and 22 drawn to a method of identifying a nucleic acid associated with a disorder, a method of identifying a subject having a disorder, a method of diagnosing a disorder, classified in class 435, subclass 6.

V. Claims 13, 16 and 22, drawn to a method of identifying a polypeptide associated with a disorder, a method of identifying a subject having a disorder, a method of diagnosing a disorder, classified in class 435, subclass 25.

VI. Claims 17-21 and 23-24, drawn to a method for identifying a compound capable of treating a disorder characterized by aberrant nucleic acid expression, a method of treating a subject having a

disorder comprising administering a modulator of a nucleic acid molecule, a method of evaluating the efficacy of treatment of a disorder, classified in class 435, subclass 6 and class 514, subclass 44.

VII. Claims 17-21 and 23-24, drawn to a method for identifying a compound capable of treating a disorder characterized by aberrant polypeptide activity, a method for treating a subject having a disorder comprising administering a modulator of the polypeptide, a method of evaluating the efficacy of treatment of a disorder, classified in class 435, subclass 25 and class 514, subclass 2.

It is noted that several of the claims are in more than one group because the claims read on using both the polypeptide and nucleic acid.

The inventions are distinct, each from the other because:

Groups I-III are drawn to completely different chemical compounds that are patentably distinct.

Inventions I and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as to produce a polypeptide or to treat a disorder as in group VI, not involving identifying the nucleic acid.

Inventions II and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can

be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used for its enzymatic activity or to treat a disorder as in group VII, not involving identifying the polypeptide.

Inventions I and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as to produce a polypeptide or to identify the nucleic acid, not involving treatment of a disorder.

Inventions II and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used for its enzymatic activity or to identify the polypeptide, not involving treatment of a disorder.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Patterson, Jr., PhD, whose telephone number is 703-308-1834. The examiner can normally be reached on Monday - Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone number is 703-308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Charles L. Patterson, Jr.
Primary Examiner
Art Unit 1652

Patterson
May 21, 2003